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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,836	12/21/2000	Edward O. Clapper	42390P10784	8616

21906 7590 11/28/2003  
TROP PRUNER & HU, PC  
8554 KATY FREEWAY  
SUITE 100  
HOUSTON, TX 77024

EXAMINER

TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

TS

**Advisory Action**

Application No.

09/745,836

Applicant(s)

CLAPPER, EDWARD O.

Examiner

BINH K. TIEU

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: Please see the attached sheets.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 28 and 30-42.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

BINH K. TIEU  
Primary Examiner  
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EXAMINER'S ADVISORY

In response to the Applicant's arguments in the last line of page 2 to the third line of page 3 wherein the Applicant stated as followings:

**"...First and foremost, please refer to original claim 21. This claim calls for "a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used," which is the exact limitation found in the claim 28..."**

The Examiner respectfully disagrees with the Applicant's arguments above. First of all, the limitations of **"a predetermined message for substitution in place of the respective caller ID value..."** in the original claim may be interpreted into different ways based on other elements recited in claim. For example, looking back historical prosecutions starting from the Office Action mailed on 09/06/2002 wherein the Examiner interpreted the predetermined message as an encoded private information stored in an universal authentication device or card as taught in Hazra et al. (U.S. Pat. #: 5,787,154). Hazra further teaches using such encoded private information as caller ID to authenticate the caller. The Examiner further combined the teachings of Hazra in view of Malik (U.S. Pat. #: 5,903,636) wherein Malik teaches using an account number of a calling card (calling card number and/or Personal Identification Number (PIN)) similar to the encoded private information taught in Hazra to retrieve its database in order to provide as supplemental caller ID value and displayed it to called party at called party terminal (please the rejection of claim 21 in Office Action on page 4 or see col.7, line 21 – col.8, line 32). In the Applicant's responses/amendment received 10/21/2002, Applicant admitted such combination of teachings of Hazra and Malik in results in cancellations of claims 12-18 and 21-

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27 and filed new claims 28-31. Applicant at that time argued that "...nowhere suggests that the telephone number is stored in the card..." See Applicant's remarks on page 2 of such amendment. Applicant did not argue or discussed about the interpretation of the predetermined message as the supplemental caller ID value as taught by Malik. The Examiner was going on to search for limitations of "the respective telephone number to be stored in the memory at a time later than the manufacturing of a calling card" argued in his remarks filed in 10/21/02 to make rejections of claim 28 in combinations of teachings of Hazra in view of Tasaki in the Final Office Action (12/4/02, paper 11). Applicant argued differently after new reference(s) applied to Office Actions. Applicant amended claims in according to the new applied references.

Finally, Applicant wrongly argued that "the cited reference (Snyder) fails to teach the predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used", and further stated that Snyder rather teaches supplemental caller ID value (see Applicant's remarks in the second paragraph, page 2 filed on 8/1/03, paper 15). In response to such arguments, Examiner had questioned supports of the specification and had a chance to discuss with the Applicant's Attorney about theses matters over the telephone interview. In the Applicant's remark filed on 11/10/2003, the applicant pointed to Specification at page 14 (the Abstract sheet), from this, is clear that a telephone caller's ID value may replaced and not supplemental by a message. The applicant further pointed to lines 14-16, page 5 and example on page 6, lines 11-16 for supporting this feature.

The Examiner respectfully disagreed with the Applicant's argued above. As previous mention in the Final Office Action that the system prompts (85) the user for her personal identification number (PIN) or other suitable identification...by swiping her calling card through

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the phone's credit card slot... According to those skilled in the art to read such phrases, it is understood that the system verifies the caller's authentication for use of such unknown Automatic Number Identification (ANI) telephone (i.e., public or pay phone) for purpose of billing or the like. It is not clear that such PIN, password or other suitable identification read from the calling card is used by a central office as substitution of caller ID value for such telephone at which the calling card is used. It is also not clear that such PIN password, etc. is used to transmit to and to displace at called party. Furthermore, the Examiner carefully read on lines 11-16, page 6. It is understood that Alice override's custom ID information by causing the central office to replace the Betty's caller ID data with Alice's customer ID information. It is noted that such predetermined message is stored and retrieved at the central office, not from a memory of the calling card.

Briefly, it is noted that **only the Abstract** on page 14 **briefly** says "An apparatus and method for a message card having a memory bearing a message for substitution in lieu, for example, a caller ID value of a phone at which the message card is used..." It is not enough for those skilled in the art to understand the invention. Therefore, the Examiner can conclude that nowhere in the specification teaches the method for reading or retrieving a predetermined message from a calling card memory **other than the PIN, password**, etc. to be used by a central office as substitution of caller ID value (i.e., ANI) of telephone at which the calling card is used. Such predetermined message is **directed** transmitted to and displaced at called party with no additional or supplemental caller ID data, as recited in claims and argued by the applicant.

With all above remarks, the Examiner believed that the specification did **not** support the feature of "a predetermined message for substitution in place of the respective caller ID value of

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a telephone at which the calling card is used." Therefore, the Examiner has maintained the rejections to the claims for purpose of future appeals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: [BINH.TIEU@USPTO.GOV](mailto:BINH.TIEU@USPTO.GOV).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

Any response to this action should be mailed to:

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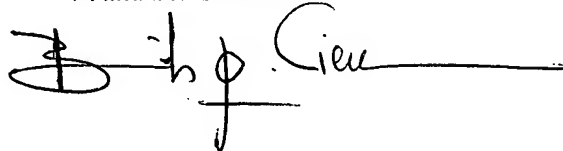
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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).

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Date: November 20, 2003

**BINH TIEU  
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "Binh K. Tieu", with a long horizontal line extending to the right.